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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,377	08/28/2000	Sergey Matasov		9553

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EXAMINER

LEUBECKER, JOHN P

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/509,377

Applicant(s)

MATASOV, SERGEY

Ch

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 20 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 2, 2004 has been entered.

Drawings

2. The drawings were received on September 2, 2004. These drawings (new Figure 5) are not accepted for the reasons regarding new matter in numbered paragraph 4 below.

Specification

3. The specification is continued to be objected to due to the enormous amount of grammatical and idiomatic errors, such errors causing ambiguity and indefiniteness. The entire specification needs to be revised. The amount of changes to be made will warrant a substitute specification. No new matter should be entered. Some examples include:

- a) sentence "The exploitation of invaginator is effective in case when it everts close to the objective and does not cover the latter" (page 1, lines 16-17).
- b) all occurrences of "invaginator" lacks a preceding article (e.g., "an" or "the").
- c) sentence "But bending of tube distal end is possible only till the definite number of curves" (page 2, lines 18-19).
- d) sense can not be made out of the whole paragraph on page 4, lines 12-18.

Appropriate correction is required.

4. The amendment filed September 2, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

a) it is noted that the subject matter which apparently describes that the working pressure is applied to gap 25 (page 10, lines 1-3) is still in the specification. As pointed out in numbered paragraph 4 of paper number 20, this subject matter was not in the originally filed disclosure.

b) The following portions of the specification introduces new matter into the disclosure: page 1, lines 19-21; page 2, lines 4-16; page 4, lines 6-10, 21-22, 25-26 and 30-37; page 6, lines 26-35; page 7, lines 22-37.

c) Figure 5 and all references to this Figure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

5. Claims 1-20 are objected to because of the following informalities:

a) all grammatical and idiomatic errors should be corrected: just some examples—claim 5, “with invaginator along rectum”; claim 16, “a distal drives of traction lines”.

b) in claim 1, “an invaginator of the endoscope tube, which an elastic tube inflated...” is improper; in addition, “an invaginator” (line 6) is mentioned but does not refer back to the one

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previously recited (unless there is a second one, in which case this should be “a second invaginator”, this term should be –said invaginator—or –the invaginator--).

c) in claim 3, recitation of the “elastic tube is gathered by pleats” and later that the “invaginator is formed of pleats” appear redundant.

These are some examples. Applicant is asked to review all the claims and correct all informalities.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 5, 12, 14 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a) Claim 5 recites “sliding seals of said endoscope tube”. The specification, as originally filed, fails to mention “sliding” seals and with respect to which element or elements they slide.

b) Claim 12 recites a “hermetic cavity”. The specification, as originally filed, fails to mention a “hermetic” cavity in association with a mechanism for introduction of the endoscope tube.

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c) Claim 14 recites that the springs are “executed with pitch”. The specification, as originally filed, fails to mention that the springs are “executed with pitch”.

d) Claim 20 recites a “method of prophylaxis”. The specification, as originally filed, fails to mention a “method of prophylaxis”.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 14 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 14, phrase “executed with pitch” is indefinite.

As to claim 20, the method is indefinite since it is not clear which are steps of a method and which are reciting structural limitations.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.

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11. Claims 1-5 and 7-11 are rejected under 35 U.S.C. 102(d) as being anticipated by Matasov (Inventors Certificate SU 1522466).

Matasov discloses an endoscopic tube (3) comprising an invaginator (4) formed of an elastic tube gathered by pleats with an uneverted end which is coupled with and held on the distal part of the tube. Inherently there is a gap between the invaginator and the endoscopic tube and the endoscopic is sealed on its distal end. A shell/anal dilator (19) is provided for insertion into the rectum. The endoscopic tube (3) inherently comprises an outer protective tube which meets the limitation of a preservative hermetically fixed to the distal and proximal part of the tube. Note spring (10).

12. Claims 1, 5 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kramann (U.S. Pat. 4,615,331).

Kramann discloses an endoscopic tube (9) having tip (11) and an invaginator (4) which is an elastic tube gathered by pleats and held at the distal end of the endoscopic tube (Fig. 1). Tube (2) anticipates the claimed shell and the anal dilator having a channel (3) in its wall. The endoscope (9) inherently has a preservative hermetically fixed to the distal tip and proximal end of the tube.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matasov in view of Avitall (U.S. Pat. 5,441,483).

Matasov discloses a bendable distal portion but fails to disclose the particulars of the bending mechanism. Since any bending mechanism could be used in the endoscope of Matasov without any effect of the operation of the disclosed device, it would have been obvious to one of ordinary skill in the art to have provided any known bending mechanism in the Matasov endoscope. Avitall discloses a bending mechanism that incorporates transverse pleats in the external cover, which are directed inwards (note 50, Fig. 1A).

15. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matasov in view of Wilk et al. (U.S. Pat. 5,396,879) for the reasons set forth in numbered paragraph 14 of the previous Office Action, paper number 20.

16. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matasov in view of Hake (U.S. Pat. 4,893,613) for the reasons set forth in numbered paragraph 15 of the previous Office Action, paper number 20.

Response to Arguments

17. Applicant's arguments filed September 2, 2004 have been fully considered but they are not persuasive.

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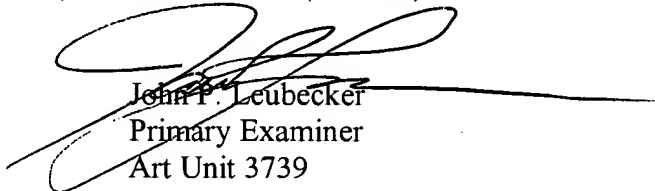
Applicant has provided evidence regarding the publication date of the Matasov Inventors Certificate (SU 1522466). Accordingly, the rejection under 35 USC 102 (b) is being withdrawn. A rejection under 35 USC 102 (d) is now appropriate.

The amendments to claim 1 and new claim 3 recite that the uneverted end of the invaginator is "held on the distal part of the endoscopic tube". Accordingly, since the Bob et al. reference does not disclose this limitation, the rejection has been withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl